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Mari Saito

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EXAMINER

ABEL JALIL, NEVEEN

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARI SAITO, NORIYUKI YAMAMOTO,
HIROYUKI HOURIN, and KAZUNORI OHMURA

Appeal 2008-1232
Application 09/785,204
Technology Center 2100

Decided: November 6, 2008

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-20. The Appellants appealed

therefrom under 35 U.S.C. § 134(a). We affirmed in part and entered a new rejection. The Appellants request rehearing of two issues and ask us to reverse the rejection of claims 5-8, 12, 13, and 20.

II. COMBINING TEACHINGS OF SCHAFFER AND CONLEY

The Appellants reiterate "that no reasonable basis has been set forth to select Conley for combination with Shaffer, in view of the disparate teachings of these references" (Req. Reh'g 5.)

A. ISSUE

Therefore, the issue is whether the Appellants have shown with particularity the points believed to have been misapprehended or overlooked by the Board in approving the Examiner's reason for combining teachings of Shaffer and Conley.

B. PRINCIPLES OF LAW

The presence or absence of a reason "to combine references in an obviousness determination is a pure question of fact." *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 1000 (Fed. Cir. 1999)). "The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents. The diversity of inventive pursuits and of modern

technology counsels against limiting the analysis in this way." *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007).

C. FINDINGS OF FACT

The Examiner specifically explains why it would have been obvious at the time of the invention to a person of ordinary skill in the art to have combined teachings of Shaffer and Conley to arrive at the claimed subject matter. To wit, he offers the following finding and conclusion.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Shaffer et al. by the teaching of Conley, Jr. et al. to include extracting attribute information from an existing text file; acquiring said associated information related to said important word selected in the selecting step; constructing a database by use of at least one of said attribute information extracted in the extraction step and said associated information acquired in the acquiring step because it provides seamless and easy system of gathering marketing information based on the end user's browser's use.

(Ans. 10-11.)

D. ANALYSIS

For its part, the "Appellants argument regarding lack of motivation" (Req. Reh'g 4) amounts to a formalistic conception of the word "motivation." Furthermore, the Appellants recognize "that the Examiner's alleged reasoning for combining the references is simply a statement of the benefits that would occur if the teachings of the references were combined." (Req. Reh'g 4.) We find that such a statement of benefits constitutes "reasons as to why an artisan would have been motivated to combine the

teachings and suggestions of the prior art" (*Id.* 4-5.) Lastly, the Appellants have not identified what they allege to be "the disparate teachings of these references" (Req. Reh'g 5.)

E. CONCLUSION

For the aforementioned reasons, the Appellants have not shown that we misapprehended or overlooked any points in our decision approving the Examiner's reason for combining teachings of Shaffer and Conley.

III. NEW ARGUMENT IN REPLY BRIEF

The Appellants argue that they "had the right to present new arguments in the reply brief." (Req. Reh'g 3.)

A. ISSUE

Therefore, the issue is whether the Appellants have identified with particularity any points believed to have been misapprehended or overlooked by the Board in declining to consider their new arguments.

B. PRINCIPLES OF LAW

"Considering an argument advanced for the first time in a reply brief . . . is not only unfair to an appellee . . . but also entails the risk of an improvident or ill-advised opinion on the legal issues tendered." *McBride v. Merrell Dow and Pharms., Inc.*, 800 F.2d 1208, 1211 (D.C. Cir. 1986) (internal citations omitted).

C. FINDINGS OF FACT

Here, the Appellants' Reply Brief includes the following new argument: "nothing in the suggestion of somehow analyzing an e-mail message or a calendar reminder from 13 teaches 'selecting an important word from among words contained in said existing text file' (emphasis added)." (Reply Br. 7.)

D. ANALYSIS

It is uncontested that the treatment of the limitation in the Examiner's Answer (p. 9) is identical to that in the Non-Final Rejection (p. 9) from which the instant appeal was taken. It is likewise uncontested that the Appellants could have made the argument in the Second Supplemental Appeal Brief. Thus, we find that an argument advanced for the first time in a reply brief would not only be unfair to the Examiner but would also entail the risk of an improvident or ill-advised opinion on the legal issues tendered.

E. CONCLUSION

For the aforementioned reasons, the Appellants have not shown that we misapprehended any points or erred in declining to consider their new arguments.

IV. ORDER

We have granted the Appellants' request to consider the aforementioned arguments, but decline their request to modify our affirmance of the rejection of claims 5-8, 12, 13, and 20.

Appeal 2008-1232
Application 09/785,204

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

DENIED

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